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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,181	09/14/2000	Richard J. McCurdy	L10389	2443

7590 02/07/2006
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EXAMINER

CHEN, BRET P

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/662,181

Applicant(s)

MCCURDY ET AL.

Examiner

B. Chen

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-42, 44, 47-55 and 87-102 is/are pending in the application.
4a) Of the above claim(s) 87-99 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 42 and 44 is/are allowed.
- 6) ☒ Claim(s) 33-41, 47-55 and 100-102 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 1762

DETAILED ACTION

Claims 33-42, 44, 47-55, 87-102 are pending in this application, which is an RCE of Serial Number 09/662181. Claims 87-99 are withdrawn from consideration as being directed to a nonelected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33-41, 47-55, 100-102 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 33 line 10, the term “in the crystalline phase” is deemed new matter. The same issue applies to claims 35, 41, 47, 49, 51, 55 and 100-102.

In claim 33 line 10, the term “photocatalytically-activated self-cleaning coating” is deemed new matter. The same issue applies to claims 35, 37, 40, 47, 49, 51, 54, 55 and 100-102.

In claim 47, the limitation “said coating has a photocatalytically-activated self-cleaning reaction rate of at least about 8.1×10^{-3} to $9.1 \times 10^{-3} \text{ cm}^{-1} \text{ min}^{-1}$ ” is deemed new matter. The same issue applies to claim 49, 51, 55 and newly added claims 100-102.

Allowable Subject Matter

Claims 42 and 44 are allowed.

Response to Arguments

Applicant's arguments filed 11/17/05 have been fully considered but they are not persuasive.

Applicant argues that the new matter rejection is not tenable and relies solely on the Third Supplemental Declaration dated 11/17/05 (pp.2-4). In that Declaration, it is argued that carrying out the process would inherently result in a crystalline coating layer over the glass float ribbon that is photocatalytically activated (paragraphs 5-7).

It is noted that the applicant's claims as presently written are not commensurate in scope with the examples set forth in the previous Declarations. Hence, the applicant has not established that the parameters recited necessarily result in the claimed properties. No further factual evidence has been provided in the Third Supplemental Declaration which is persuasive that the properties deemed new matter are inherently a result of the claimed process. In addition, there is no factual evidence that the claimed properties were in possession of the applicant at time the application was filed.

Applicant's arguments have been considered but are not deemed persuasive.

Art Unit: 1762

Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. Chen whose telephone number is (571) 272-1417. The examiner can normally be reached on 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bc
2/4/06



BRET CHEN
PRIMARY EXAMINER